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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/181,108 10/28/98 MILLER B 176/60440-(1

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EXAMINER

MCCARTHY III, T

ART UNIT	PAPER NUMBER
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1618

DATE MAILED:

12/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/181,108

Applicant(s)

Miller et al.

Examiner

McCarthy, T.C.

Group Art Unit

1618

☒ Responsive to communication(s) filed on Oct 28, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-40 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

I. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a combinatorial library, class and subclass will vary depending on the compounds comprising the library.
- II. Claims 11-22, drawn to a composition, class and subclass will vary depending on the composition used.
- III. Claims 23-35, drawn to an assay method, class and subclass will vary depending on the compounds being tested and the test ligands being used.
- IV. Claims 36-40, drawn to a method for making a combinatorial library, class and subclass will depend on the compounds comprising the library.

Inventions I and II are different. A library is by definition two or more compounds/compositions, and is used for different purposes than are individual compositions (i.e. for screening and identification of pharmacophores). Therefore a reference reading on one composition would not read on a library, and restriction between these inventions is proper.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

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product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can also be used to test the compounds' binding affinities to ligands of receptors to test for active inhibitors of receptor-binding ligands - in any one of the almost infinite number of art-known, materially different assay formats.

Inventions I and IV are related as product and process of making. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP ' 806.05(f)). In the instant case, the product as claimed can be made using any number of art known methods and reagents (i.e. classical serial/benchtop synthesis, light-directed methods, channel-flow methods, etc.).

Inventions II and III are different. The product of invention II can be used for many purposes (i.e. herbicide, etc.), and the process of invention III is practiced using a library – not a composition. Furthermore, the steps used to practice invention III do not result in the production of a composition. Therefore, art reading on the composition would not read on the assay and restriction of these inventions is proper.

Inventions II and IV are different. The product of invention II can be used for many purposes (i.e. herbicide, etc.). Furthermore, the process of invention IV does not result in the production of a single composition, and the steps and reagents required to produce a library of two or more different compositions are different from those required to produce a single

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composition. Therefore, art reading on the composition would not read on the method for preparing a library, and restriction of these inventions is proper.

Inventions III and IV are different. The steps and reagents required to practice invention III are different from those required to practice invention IV, and the two processes are practiced for different purposes. Therefore, art reading on one invention would not read on the other, and restriction is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. However, some of the above distinct inventions may fall within the same class and subclass. In these cases, restriction is also proper because of the reasons listed above, and because these inventions have acquired a separate status in the art due to their recognized divergent subject matter.

Election of Species

Should the applicant elect any one of inventions I-III, an election is also required with respect to the following patentably distinct species in the claimed invention: the type of complex comprising the library. Each of listed the complexes have different structures and functional groups, such that a reference reading on one would not render the others obvious. Applicants are therefore required to elect a single compound formula (i.e. the formula of claim 9 in invention I).

Currently, claims 1, 11, and 23 are generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP ' 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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A telephone call was made to Michael Goldman on November 23 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T.C. McCarthy whose telephone number is (703) 308-5316. The examiner can normally be reached on Monday to Friday from 8:30 am to 5:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, can be reached on (703) 308-0570.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7924.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

September 28, 1999

T.C. McCarthy III, Ph.D.


KEITH D. MacMILLAN
PRIMARY EXAMINER